

REMARKS

Entry of the foregoing and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow.

Claims 2-6, 8-18 and 20-33 were pending. Claims 22, 23, 26 and 27 have been previously canceled by the previous response. By the present response, claims 29, 32 and 33 have been amended and claims 34-38 added. Thus, upon entry of the present response, claims 2-6, 8-18, 20-21, 24-25 and 28-38 remain pending and await further consideration on the merits.

Support for the foregoing amendments can be found, for example, in at least the following locations in the original disclosure: the original claims, and Figures 4, 5 and 6.

CLAIM REJECTIONS UNDER 35 U.S.C. §102

Claim 29 stands rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 5,492,315 to Maruyama et al. (hereafter "*Maruyama et al.*") on the grounds set forth in paragraph 3 of the Official Action. For at least the reasons noted below, this rejection should be withdrawn.

Claim 29, the only claim subject to this rejection, is directed to a sheet-wise binding system. As set forth in claim 29, the sheet-wise binding system comprises, *inter alia*, a sheet transport path, a trimmer, a stacking system, a binding system, and a controller. The sheet transport path transports a plurality of printed sheets in a sheet-wise manner. The trimmer is configured to trim the edges of the sheets traveling through the sheet transport path to form a saw tooth edge feature. The

stacking system stacks the trim sheets and the binding system binds the stacked sheets to form a finished document. The controller controls the sheet transport path and the trimmer to trim the edges of the sheets at a varying depth according to a trim schedule to create the saw tooth edge feature. The saw tooth edge feature includes a plurality of document portions, each document portion including a plurality of trim sheets of varying trim depths to expose a surface of a first visible trim sheet of an adjacent document portion. A portion of the trim sheet removed to the varying trim depth is an entire edge of the trim sheet.

The *Maruyama et al.* patent discloses a sheet post-treatment apparatus having a tab trimmer 54 (see Figure 30). The tab trimmer provides multiple sheets with a tab as shown in Figure 31. Figure 31 shows that the tabs (1, 2, 3, 4, 5) are offset along an edge of the sheet so that, when stacked one on top of the other, each of the tabs is exposed to view. Figures 32a and 32b show a similar construction for the tab, albeit with a position that is movable in an up and down direction. See column 6, lines 43-56. This up and down direction varies the position of the tab along the edge of the sheet.

Comparing the disclosure in *Maruyama et al.* to the claims of the present application at issue here, the *Maruyama et al.* patent does not disclose a sheet-wise binding system with the claimed arrangement of features. Specifically, *Maruyama et al.* at least does not disclose removing an entire edge of the trimmed sheet to the varying trim depth. In light of at least this difference, applicants respectfully submit that an anticipatory rejection is improper since *Maruyama et al.* does not disclose the invention as claimed.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

Claims 32, 20, 21, 24, 25, and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Maruyama et al.* in view of U.S. Patent No. 4,819,021 to Doery (hereafter "*Doery*") on the grounds set forth in paragraph 5 of the Official Action. For at least the reasons noted below, this rejection should be withdrawn.

The rejection based on disclosures in *Maruyama et al.* and *Doery* is improper because the combination of references does not teach or suggest all of the claim limitations of independent claim 32. See MPEP §2143.

Maruyama et al. discloses a sheet post-treatment apparatus having a tab trimmer 54 and provides multiple sheets with a tab as shown in Figures 31-32b. These features have been previously discussed herein. *Doery* also discloses cutting of tabbed sheets 28 with a tab generating system 30. Applicants have previously noted that the tab cutting system of *Doery* illustrated in Figure 3 produces a fixed depth tab, e.g., the depth of the tab is from the edge of the sheet containing the tab. The fixed depth is limited by the fingers 34 which provide registration for stopping and aligning the copy sheet 26 at a tabbing registration position. See column 5, lines 38-51. Cutting wheels 38 and 39 are advanced along rails 42 and 43 to provide a tab 28. The cutting wheels 38, 39 do not have any variation and depth. In other words, the disclosure in *Doery* positioned the sheet 26 in a fixed position according to registration features 34 and then cutting wheels 38, 39 are translated to cut a fixed depth tab in the edge of the sheet.

The Examiner in response to this argument has referenced column 7, lines 35-40 as disclosing punching the sheets at variable depth in a direction

perpendicular to an edge of the sheet. Applicants respectfully disagree. Column 7, line 35 *et seq.* of *Doery* discloses longer (wider) tabs.

However, the Examiner has not considered the additional claim language wherein the variable depth of the feature is in a direction substantially perpendicular to an edge of the sheet on which the feature is to be formed. *Doery* can vary the position of the tab along an edge on which the feature is formed, namely, along the edge from the top edge to the bottom edge of a sheet. In contrast, the claim feature has a variable depth in a direction substantially perpendicular to an edge of the sheet on which the feature is to be formed, for example, the edge of the sheet opposite the bound edge in a booklet. Therefore, even if one were motivated to combine the disclosures in *Maruyama et al.* and *Doery*, applicants' claim 32 method of binding sheets to form a document would not have resulted. Namely, *Doery* leads one to vary the position of the tab along the edge of the sheet and not in a direction substantially perpendicular to the edge of the sheet on which the feature is to be formed. For at least this reason, a *prima facie* case of obviousness has not been established and the rejection should be withdrawn.

NEW CLAIMS

Applicants submit herewith new claims 34-38 which include additional features and characteristics of applicants' claimed system and method. These claims distinguish over the cited references for at least the same reason as the independent claims from which they depend.

ALLOWABLE SUBJECT MATTER

Applicants note with appreciation the indication that claims 2-6, 8-18, 30 and 31 contain allowable subject matter, as noted in paragraphs 6-7 of the Official Action, and that claim 33 would be allowable if rewritten in independent form. By the present response, claim 33 has been amended to independent form and is considered allowable over the cited references. In addition, independent claims 29 and 32 distinguish over the cited references and, together with there dependent claims, are allowable over the cited references.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

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